

***United States Court of Appeals
for the Second Circuit***



**APPELLANT'S
REPLY BRIEF**

74-2540

ORIGINAL

To be argued by
ROY C. HOPGOOD

United States Court of Appeals

For the Second Circuit

ABERCROMBIE & FITCH COMPANY,

Plaintiff-Appellant,

v.

HUNTING WORLD, INCORPORATED,

Defendant-Appellee.

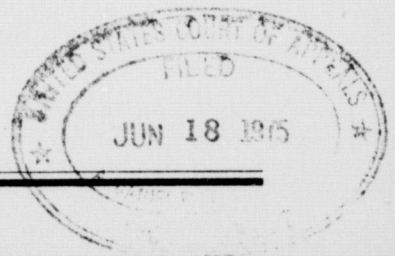
On Appeal from the United States District Court
for the Southern District of New York

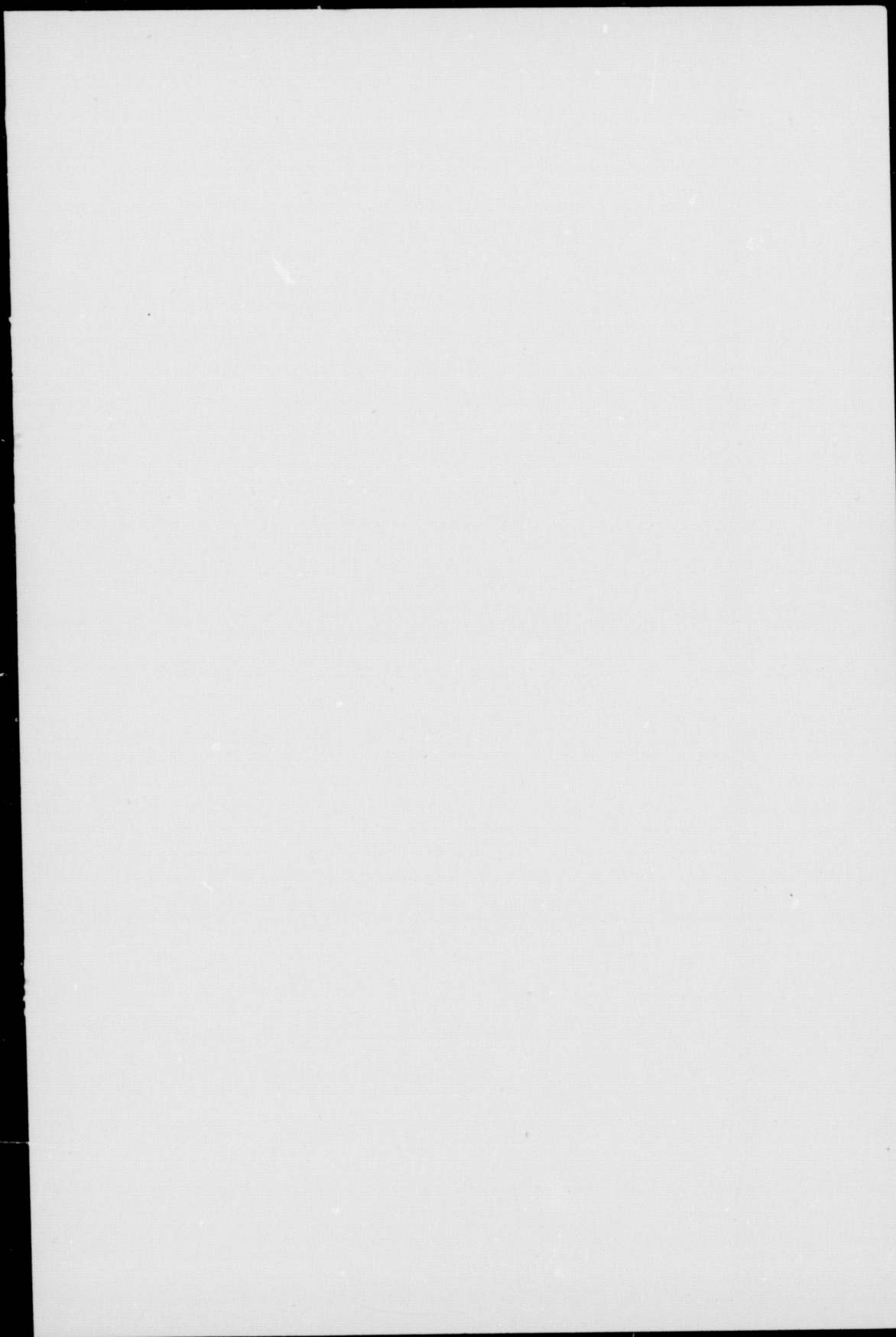
Civil Action No. 70 Civ. 377, Ryan, J.

PLAINTIFF-APPELLANT'S REPLY BRIEF

ROY C. HOPGOOD
HOPGOOD, CALIMAFDE, KALIL, BLAUSTEIN & LIEBERMAN
Attorneys for Plaintiff-Appellant
60 East 42nd Street
New York, New York 10017
(212) 986-2480

PAUL H. BLAUSTEIN
Of Counsel





United States Court of Appeals

For the Second Circuit

Appeal No. 74-2540

ABERCROMBIE & FITCH COMPANY,

Plaintiff-Appellant,

v.

HUNTING WORLD, INCORPORATED,

Defendant-Appellee.

On Appeal from the United States District Court
for the Southern District of New York

Civil Action No. 70 Civ. 377, Ryan, J.

PLAINTIFF-APPELLANT'S REPLY BRIEF

Defendant's basic position is that plaintiff does not have and cannot have any trademark rights in the dictionary word "safari", regardless of the products on which it has been used or the manner of use. Multiple arguments are advanced, some contradictory, some ignoring defendant's own uses of trademark designations (i.e. the symbol "TM"), but all ignoring fundamental legal distinctions which we contend must be considered in order to properly analyze the multiple uses of "Safari" now before this Court.

First, defendant says that "Safari" is a descriptive, geographic, and generic word (D.Br. 3).^{*} But the word cannot be all three at once. A generic word is the name of a product (P.Br. 16). It has no other meaning. Safari, as a generic word has only one meaning—that of a journey or expedition. A geographic term ("geographically descriptive", 15 U.S.C. 1052(e)) refers to location. A descriptive use is different from a generic use and from a non-descriptive use. A descriptive use describes a quality or use, but not the product itself (P.Br. 19-21). On the other hand, a suggestive or fanciful use is a non-descriptive use (P.Br. 17-18).

Secondary-meaning evidence can be used only if a mark is descriptive; if the mark is generic, such evidence is of no value since the generic meaning has become fixed (e.g. aspirin, elevator, thermos). And if the mark is non-descriptive, as when used in a suggestive or fanciful sense, secondary meaning should not be required—as a matter of law (P.Br. 32).

Defendant ignores these distinctions, attempting to justify the widest spectrum of goods which it may use with "safari".

We cited *Venetianaire Corp. v. A & P Import Co.*, 429 F. 2d 1079 (2d Cir. 1970) and others (P.Br. 16-19), for the principle that trademarks must not be considered apart from their use. Although *Venetianaire* involved package copying as defendant points out (D.Br. 40), we submit that *Venetianaire* must be followed, for its instruction to evalu-

^{*} We will refer to Defendant's Brief on Appeal as D.Br. and to our main brief on appeal as P.Br.

ate the meaning of "safari" and its use as the starting point in resolving the issues on appeal.

We have emphasized that the issue before this Court requires that a line be drawn between the "right doing" of plaintiff and defendant (P.Br. 22). Defendant's brief responds by saying, in effect, draw no line at all!

It defies reason to hold that the uses of "safari" are descriptive or generic for a fishing hat or sneakers. These we submit are clear valid trademark uses.* This conclusion applies with equal or more force to luggage, portable grills, insulated ice chests, camping tents, axes, and smoking tobacco—all of which are goods involved in plaintiff's registrations which were not in issue or of record, but which were nevertheless ordered cancelled; we submit that such action was improper (P.Br. 33, Point V). Even if these registrations were in issue, we submit that the goods stated therein should fall on the safe side of the line.

With respect to the use of "Safari" in connection with shoes, considered non-descriptive uses by Judge Ryan and by Judge Lasker (P.Br. 19), defendant says only that its shoes are made in Africa, are used on African safaris, and are imported into the U.S. for use in its safari outfitting business (D.Br. 37). Yet defendant's "SAFARI CHUKKA" was advertised as utterly luxurious (PX-61), the shoes were said to be handcrafted in England by skilled Europeans (PX-56) and were advertised with unusual words to appeal to the affluent world, "CAMEL SAFARI"

* The fishing hat and sneakers were singled out by Judges Ryan and Lasker, but a reading of the goods recited in plaintiff's registrations at issue (P.Br. 4) and consideration of their uses (P.Br. 5) shows many non-descriptive uses, all clearly labeled "Safari" (PX-30).

and "HIPPO SAFARI" (P.Br. 24). While defendant operates a safari outfitting shop, it also operates as a mid-Manhattan department store selling status-symbol products including hats and shoes for use on Fifth Avenue (P.Br. 11). Defendant cannot use its safari-expedition business to justify the use of "Safari" or "Safariland™" in its business to appeal to those who want distinctive gifts, who are not outdoor people and who do not go on safaris (PX-71; A 377, 378 and 394).

We submit that plaintiff's and defendant's uses of "safari" for shoes are non-descriptive uses. Plaintiff need not establish secondary meaning, and defendant's uses of "HIPPO SAFARI", "CAMEL SAFARI" and "SAFARI CHUKKA" are not fair uses "only" to describe. They are infringements.

The same applies to "Minisafari". "Minisafari" is not a generic word; arguably, it is supposed to describe a miniature safari hat. But a safari hat is used, or is intended to be used on a safari. "Minisafari" is intended to be a trademark for defendant's product; the symbol "TM" is used (PX-44; A 274; P.Br. 25), and the hat looks like an ordinary hat—or at least a stylish hat (see P.Br. 25). It does not look like a miniature safari hat because the distinctive wide brim of a safari hat has been eliminated.*

It does not matter where the hat is made. The issue would be the same even if the hat were made by safari

* Although Judge Lasker said that "minisafari" was literally descriptive, a conclusion we resist, he also said, somewhat contradictorily that "minisafari" was "sufficiently distinct from the use of 'safari' alone not to connote the same origin" (A 36).

hunters in Africa for evening entertainment. We contend that defendant's "Minisafari" use is not a fair use, and that the evidence as to infringement is conclusive, and rises to an estoppel (P.Br. 27).

We previously stated that most of the advertising evidence offered by the defendant to establish that safari was a generic word related primarily to jacket and jacket-pant combinations.*

The defendant's third-party uses show popularity of safari with leisure jackets and pants; and they also show other proper and improper trademark and non-trademark uses.** They do not establish safari to be the generic name of *all* products involved in the scope of Judge Ryan's decision. And despite many improper and unfortunate advertising uses (D.Br. 32), Abercrombie should not be deemed to have abandoned its trademark rights. Abercrombie's advertising does not prove safari to be generic or descriptive for all uses. The Court, we submit, must draw the line between valid trademark use and descriptiveness.

* See P.Br. 15. Defendant additionally refers to DX-B, C, G, L, N, O, P, Q, R, S, T, W, Y, Z, NN, III, LLL. Of these, DX-B relates to a bar glass showing a "Safari Animal"; DX-N, P, R relate to bags. DX-Q, W, NN relate to clothing with a tiger motif; DX-III relates to the ordinary use of safari; DX-Z relates to use with guns; DX-LLL, C relate to single uses of "City Safari" as a hat, which uses have been discontinued. The remaining uses were jacket and pants uses.

** We note that, at D.Br. 28, the defendant referred to a *New York Times* article which is outside the record of this proceeding. Articles in the *New York Times* are not judicially recognized as being the Gospel truth. Therefore, we request the Court to ignore any evidentiary matter outside the record in this action, particularly a hearsay article.

And it cannot be overlooked that, while defendant attempts to show widespread use of safari by the public in many different modes of trademark and non-trademark use, defendant still uses "Safariland" and "Minisafari" as trademarks, often with symbol "TM".

Conclusion

We submit that plaintiff's registrations which are outside the record in this action were improperly cancelled, and that they should be restored to their proper register; that plaintiff has not lost all of its trademark rights to "Safari"; and that, as to the uses of "Safari" which are non-descriptive, plaintiff's trademarks are valid and have been infringed.

Respectfully submitted,

/s/ Roy C. HOPGOOD

ROY C. HOPGOOD
HOPGOOD, CALIMAFDE, KALIL, BLAUSTEIN & LIEBERMAN
Attorneys for Plaintiff-Appellant
60 East 42nd Street
New York, New York 10017
(212) 986-2480

PAUL H. BLAUSTEIN
Of Counsel

Service of 3 copies of the
within Brief is hereby
admitted this 18th day of
June 1975
Signed Mrs. W. L. [unclear]
Attorney for Defendant-Appellee